

**REMARKS**

Claims 1-23 are pending in this application; claims 1 and 13-17 being independent. Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections in light of the following remarks.

**The Official Action**

In the Office Action dated October 28, 2002, the Examiner rejected claims 1-7, 9, 11, 13-16, and 18-23 under 35 U.S.C. § 102(e) as being anticipated by *Ma* (USP 5,880,928); rejected claims 17 and 23 under 35 U.S.C. § 102(e) as being anticipated by *Brenner* (USP 5,786,983); and rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over *Ma* in view of *Smith, II* (USP 5,768,163). Applicant respectfully traverses these rejections.

Applicant wishes to thank the Examiner for noting that claim 8 contains allowable subject matter.

**Claim Rejections - *Ma***

With regard to the Examiner's rejection of claims 1 and 13-16 under 35 U.S.C. § 102(e) as being anticipated by *Ma*, the Examiner asserts that the functional recitation that the chamber is capable or adapted to interchangeably accept the external device does not have any patentable weight. In support of the Examiner's assertion, the Examiner cites to *In re Hutchison*, 69 USPQ 138 (CCPA, 1946).

It is respectfully submitted that the holding of the Court in *In re Hutchison* does not support the Examiner's assertion. The Court in *In re Hutchison* was considering the patentability of the following claim 42 at 140

42. As an article of manufacture, *adapted for use in the fabrication of a metal template or the like suitable for metal-working operations*, a laminated unit comprising a backing element surfaced with paper having an exposed outer surface to receive ...

In deciding the patentability of the functional “adapted” clause as italicized above, the Court stated at 141

Taking first claim 42 for analysis and comparing it principally with the Moxon patent, the first phraseology italicized by appellant is the introductory clause to the effect that the laminated article is “adapted” for use in making a template or the like. This does not constitute a limitation in any patentable sense, but if it were in that category, it is anticipated by Moxon who teaches that his laminated sheet (made up of layers of paper and metal, united by an adhesive) may be used in making a template.

As such, the court stated that the functional “adapted” clause did not constitute a limitation in any patentable sense since the clause appeared in the introduction, or the preamble, of the claim. As such, the Examiner’s statement that any recitation of an element that is “adapted to” or “capable of” performing a function that is not a positive limitation does not have patentable weight is an erroneous characterization of the Court’s decision. The Court did not hold that all functional “adapted to” clauses do not have patentable weight. The Court merely found that since the “adapted to” clause appears in the introduction, or the preamble, of the claim, it does not have patentable weight.

Additionally, it is respectfully submitted that the Examiner admits that the functional clause requires the prior art to have the ability to perform the function. Since claim 1 recites, *inter alia*, a personal computer comprising a chamber capable of interchangeably accepting an external device, it is respectfully submitted that the camera hole 22 of *Ma* is not capable of accepting an external device. As such, by Examiner’s own admission, the device disclosed in the *Ma* reference does not have the

ability to perform the "function" as set out in claim 1, namely a chamber capable of interchangeably accepting an external device. As such, it is respectfully submitted that the clause "a chamber capable of interchangeably accepting an external device" should be afforded patentable weight. Further, it is respectfully submitted that *Ma* fails to anticipate the personal computer set forth in claim 1.

The Examiner additionally asserts in support of his rejection that the functional recitations are not to be given patentable weight because they are in narrative form. It is respectfully submitted that claims, by their nature are in narrative form. Under 37 C.F.R. § 1.75, claims must particularly point out and distinctly claim the subject matter which the applicant regards as his invention or discovery. The MPEP, in Section 608.01(m), requires that each claim be the object of a sentence starting with "I (or we) claim," or some equivalent. Further, this section requires that each claim begin with a capital letter and end with a period. Finally, the section requires that where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There is no qualification either in the rules or the statutes that functional language in narrative form is not afforded patentable weight. In fact, courts have explicitly stated that functional weight is afforded to functional language in the claims.

Courts have found that functional elements should be considered in claim analysis. In *Clements Industries Inc. v. A. Meyers & Sons Corp.*, 12 USPQ.2d 1874 (SD NY 1989), the Court stated "We are aware that functional language such as that here at issue ... is allowed in claims and is entitled to full weight in claim analysis" citing to *In re Swinehart and Sfiligoj*, 169 USPQ 226 (CCPA 1971). See also *In re Caldwell*,

138 USPQ 243 (CCPA, 1963). The Courts have considered functional language in connection with anticipation and obviousness issues.

It appears that the Examiner is confused regarding when functional recitations render a claim patentable. As set forth in the *Clements* decision, the court held that "where the construction disclosed in the prior patent would inherently accomplish the general purpose of the patent-in-suit, then the later patent cannot stand." It is respectfully submitted that, in the present case, the device in the *Ma* reference cannot accomplish the generally purpose of the invention set forth in the present application, namely having the chamber interchangeably accepting an external device.

Further, the Examiner's assertion that in order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function as set forth in 35 U.S.C. § 112, 6<sup>th</sup> paragraph, is clearly erroneous. Functional language may be included in many different types of claims, including method and apparatus claims and are still afforded patentable weight. See *Clements* and *Swinehart*. 35 U.S.C. § 112, 6<sup>th</sup> paragraph, states "[a]n element for a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." There is no requirement that that functional recitations be written in the means-plus-function form.

Further, the Examiner relies on *In re Fuller*, decided in 1929, in support of his assertion that the functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 U.S.C. § 112, 6<sup>th</sup> paragraph, and must be

supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. It is respectfully submitted that *In re Fuller* predates 35 U.S.C. § 112, sixth paragraph. As such, it is unclear how the Examiner is interpreting the Court's decision. Applicant submits that the Examiner's interpretation of the Court's holding is erroneous.

The Examiner asserts *Ma* discloses a chamber capable of accepting an external device 222 or 212 enhancing a function of the personal computer, the chamber being arranged in the display unit, citing to external devices 222 or 212.

It is respectfully submitted that *Ma* teaches a notebook computer with audio and video effects. As shown in Fig. 2, CCD camera 222 and sound boxes 212 contain wires that indicate a permanent connection to the computing device.

In contrast, the present invention as set forth in claim 1 recites, *inter alia*, a personal computer comprising a chamber capable of interchangeably accepting an external device. It is respectfully submitted that *Ma* fails to teach a chamber capable of interchangeably accepting an external device and, thus, claim 1 is not anticipated by *Ma*.

It is respectfully submitted that claims 2-12 are allowable for the reasons set forth above with regard to claim 1 based upon their dependency on claim 1.

Claim 13 recites, *inter alia*, a personal computer comprising a chamber disposed within the display unit, the chamber adapted to interchangeably accept at least a portion of an external device. As noted above, *Ma* discloses a permanent connection between CCD camera 222 and the computing device. As such, *Ma* fails to teach the chamber adapted to interchangeably accept at least a portion of an external device

and, thus, claim 13, together with the respective dependent claims, are not anticipated by *Ma*.

It is respectfully submitted that independent claim 14 recites, *inter alia*, a method for providing an interface to an external device in a computer comprising providing an electrical connection inside the chamber such that at least a portion of the external device is capable of being inserted into the chamber such that an electrical connection is established therewithin between the external device and the electrical connector. It is respectfully submitted that CCD camera 222 and sound boxes 212 contain wires that indicate a permanent connection to the computing device. *Ma* does not teach establishing an electrical connection between the external device and the electrical connector when the external device is inserted into the chamber. As such, it is respectfully submitted that independent claim 14, together with the respective dependent claims, are not anticipated by *Ma*.

It is respectfully submitted that independent claim 15 contains elements similar to those discussed above with regard to claim 13 and, thus, claim 15, together with the respective dependent claims, are not anticipated by *Ma* for the reasons set forth above with regard to claim 13.

It is respectfully submitted that independent claim 16 recites, *inter alia*, an apparatus for interfacing a computer with an external device, the apparatus comprising a chamber having an opening disposed on the outside of the display unit configured to adaptably receive the external device. As noted above, the devices in *Ma* are permanently connected to the computing device. As such, the chamber of *Ma* is not

configured to adaptably receive the external device. As such, independent claim 16, together with the respective dependent claims, are not anticipated by *Ma*.

**Claim Rejections – *Brenner et al.***

The Examiner rejected claim 17 under 35 U.S.C. § 102(e) as being anticipated by *Brenner et al.* By this amendment, Applicant has amended claim 17 to more appropriately recite the present invention.

It is respectfully submitted that *Brenner et al.* teaches an information device with display and keyboard having corresponding sets of function keys. Specifically, *Brenner et al.* teaches at col. 4, lines 9-18

Figs. 1-7 illustrate a computer 100, having a housing 110, a keyboard 112 and an attached printer 118. As shown in block diagram form in Fig. 27, the control system 200 of the computer 100 includes a controller 210, a memory 220 and a bus 230 interconnecting the controller 210 and the memory 230. The bus 230 of the computer 100 is connected to an AC or a DC power source 240 that supplies power to the control system 200 when a power switch 130 is in an "ON" position.

It is respectfully submitted that amended claim 17 recites, *inter alia*, a method for providing an interface to an external device in a computer comprising forming a chamber inside a display unit coupled to the computer, the display unit having a display face and being movably coupled to a base unit such that the display face forms an angle generally less than 180° with the base unit, and the chamber having walls for covering a bottom side, a right and left side, and a front and back side of the external device, wherein the chamber is configured to interchangeably receive the external device.

It is respectfully submitted that *Brenner et. al.* fails to teach forming a chamber inside a display unit coupled to the computer, the display unit having a display face and being movably coupled to a base unit such that the display face forms an angle

generally less than 180° with the base unit, and the chamber having walls for covering a bottom side, a right and left side, and a front and back side of the external device, wherein the chamber is configured to interchangeably receive the external device. As such, claim 17, together with the respective dependent claims, are not anticipated by *Brenner et. al.*

**CONCLUSION**

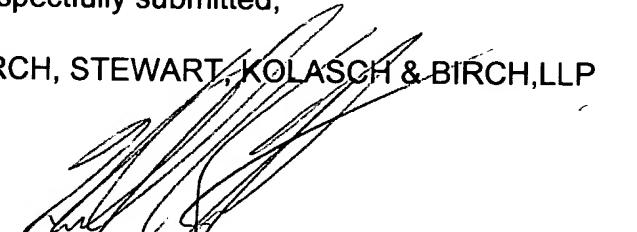
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Registration No. 52,327) at (703) 205-8000, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: Version With Markings to Show Changes Made

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

The claims have been amended as follows:

17. (Twice Amended) A method for providing an interface to an external device in a computer comprising:

forming a chamber inside a display unit [for the] coupled to the computer, the display unit having a display face and being movably coupled to a base unit such that the display face forms an angle generally less than 180° with the base unit, and the chamber having walls for covering a bottom side, a right and left side, and a front and back side of the external device, wherein the chamber is configured to interchangeably receive the external device; and

forming an opening associated with the chamber such that only the opening of the chamber is disposed on the outside of the display unit.